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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,009	08/25/2003	Amlan Datta	129843.1104	3329
60148 7590 06/18/2007 GARDERE / JAMES HARDIE GARDERE WYNNE SEWELL, LLP 1601 ELM STREET SUITE 3000 DALLAS, TX 75201			EXAMINER MARCANTONI, PAUL D	
			ART UNIT 1755	PAPER NUMBER
			MAIL DATE 06/18/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



The applicants' 4/2/07 response has been considered but is unpersuasive.

Provisional ODP

Claims 1,5, 6, and 12-15 remain provisionally rejected on the grounds of non-statutory obviousness type double patenting as being unpatentable over claims 1-27 and 1-15 of copending application nos. 2004/0081827 A1 (Datta et al.) and 2004/0079260 A1 (Datta et al.). Although the conflicting claims are not identical, they are not patentably distinct from each other because both teach a composition comprising microspheres that overlap the composition of one another. Overlapping ranges of amounts would have been prima facie obvious to one of ordinary skill in the art. Further, the applicants' new intended use of a known composition in their claims 12-15 is not a patentable distinction. The new use of a composition that is already known is not patentable.

ODP-Now Withdrawn

The ODP over Gleeson '697 has been withdrawn because Gleeson '697 teaches his microspheres used for his building material are fly ash cenospheres. The amount of CaO for fly ash cenospheres is outside applicants' higher claimed range. See Table 2, column 3, lines 1-12 of Gebhart (US Patent No. 3,782,985) who teaches a specific composition in weight percent for fly ash cenospheres. The amount of CaO in fly ash cenospheres is 0.2 to 0.6 wt% which is well below applicants claimed amount of *not less than 5.2 wt% to about 30 wt% calcium oxide*. (see applicants claim 1). This is the only reason this reference was withdrawn; the lack of overlap of CaO.

The examiner disagrees with applicants' assertions that the Gleeson (which prefers fly ash cenospheres but does not provide other examples that can be used) does not teach about 4 to 10 wt% sodium oxide or less than 2 wt% potassium oxide. First, the amount of potassium oxide can be zero or read upon zero. Second, Gleeson does teach an overlapping amount of sodium oxide (See Table 2, col.3, of Gebhart '985) with a range of sodium oxide of 0.5 to 4.0 wt%. Nevertheless, the amount of CaO differs from applicants' claims and Gleeson has been now withdrawn.

35 USC 102/103:

Claims 1,5,6, and 12-15 are rejected under 35 USC 102(b) as anticipated by, or, in the alternative, under 35 USC 103(a) as obvious over Beck et al. (3M Patent-US Patent Number 3,365,315-also listed on page 11 paragraph [0038] of applicants' specification) or Goetz et al. (US Patent Number 4,983,550).

Response:

Provisional ODP over '827 A1 (Datta et al.) and '260 A1 (Datta et al.)

Applicants state that the examiner must determine which application claims the base invention and which claims the improvement when co-pending applications are filed on same day and upon such a determination, the rejection for the base application is withdrawn (thus removing the requirement for filing a terminal disclaimer). The examiner was referred to MPEP 804. In rebuttal, it does not clear how the examiner is required to point out which application points out the base invention and which application claims the improvement. It would seem that applicants would know best (than including the examiner) the answer to this question. The examiner respectfully

asks applicants for their assistance and opinion regarding which application is the base invention and which is the improvement. The examiner cannot clarify between the two applications as to which is which. The examiner will then in turn take the next step and withdraw the base application versus the improvement application (evidently because one has to be allowed before a terminal disclaimer can be filed).

The examiner also points out that page 3, paragraphs [0054] and [0055] of Datta they teach applicants claims 1 and 6 and applicants' remaining claims are intended use claims. The new use of a known composition is not a patentable distinction.

35 USC 102/103:

Beck:

The applicants state that Beck is not really an aluminosilicate. This assertion is not understood as Beck teaches a raw material glass made from alumina and silica so it would follow that it is an aluminosilicate material. The applicants also make a statement that is not factually correct. They state that the aluminum oxide content is specifically taught *a/ways* to be less than 1.2 wt% and they refer the examiner to the examples. In rebuttal, this statement is not correct. The aluminum oxide content can be in the range of 0 to 20 wt% (see Table I, col.4 of Beck). Further, a reference is good for all that it realistically teaches and it is not limited to the specific examples or preferred embodiments. Therefore, aluminum oxide content is not always less than 1.2 wt%. Note that applicants own claims do not even require iron oxide so the presence of iron oxide is not relevant to applicants' claimed invention. Beck teaches a range of alumina of 0 to

20 wt% thus meeting applicants' claims. This listing of amounts in Table I is very specific as well to teach Beck's invention.

The applicants make general assertions regarding reasonable doubt in the field of chemistry and re-arrangement of parts cannot support obviousness. The applicants seem to arguing that Beck cannot use his own invention. The examiner disagrees and refers applicants back to Beck's Table I in column 4 which teaches the *specific* components and amounts claimed by applicants. There is no reasonable doubt (in chemistry or any other scientific endeavor) with respect to Beck's Table 1 ranges because this is the specific teaching of the compositional analysis of what qualifies as his own invention. The applicants are also and again referred to claim 1 in column 8 for Beck wherein a particle diameter of between 5 to 300 microns is taught which overlaps applicants' claimed range of 30 to 1000 microns in their claim 1.

Goetz:

The applicants argue that Goetz does not teach microspheres having less than about 2 wt% potassium oxide and that Goetz requires 3.8 to 10 wt% of potassium oxide (col.3, lines 24-26). This statement is factually incorrect. Col.3 lines 22-23 (and claim 1), just above where applicants refer examiner, it teaches that R<sub>2</sub>O or K<sub>2</sub>O (potassium oxide) is present in the amount of between 2 and 15 wt%. Therefore, it reads upon applicants range of less than about 2 wt% potassium oxide. Note that "about" permits some tolerance and applicants lower limit of "about 2 wt% potassium oxide" can be an amount greater than the lower limit of Goetz of between 2 wt%. The applicants would be correct if they did not use " less than about 2 wt% potassium oxide" but only used

Art Unit: 1755

"less than 2 wt% potassium oxide" but that is not what they are presently claiming. Also, it is noted that this statement by the examiner is not a suggestion but only an observation or commentary on the present state of applicants' claims and a rebuttal to their own presented arguments.

The applicants also argue R2O3 is boron oxide. The examiner disagrees and notes that R2O3 is alumina and Goetz even teaches an amount of alumina or R2O3 (other than boron oxide) of 0 to 10 wt%.

Applicants also argue examples with respect to alumina and boron oxide amount. In rebuttal, a reference is good for all that it realistically teaches and is not limited to the examples or preferred embodiments. Goetz teaches specific ranges in claim 1 of the same components and in overlapping amounts of applicants own invention and thus meets the limitations of applicants claims.

The examiner has fully addressed applicants' arguments and the finality of this office action is now proper. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 1755

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is 571-272-1373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul Marcantoni  
Primary Examiner  
Art Unit 1755